

REMARKS

The Examiner's Action

The Examiner's Action rejected claims pending claims 1-17 for being anticipated or failing to define nonobvious subject matter over the selected teachings drawn from two particular references. The Action neglected to examine Claim 18 added in the Preliminary Amendment of September 22, 2003.

The Subject Invention

For purposes of review, the subject invention is particularly applicable to a method and system for generating useful and/or appreciated unknown information to a user as part of a normal printer job. Such print jobs usually include a cover page identifying the job and the user of the printer. Since the identifying information is small, the cover page normally includes a good deal of unused white space. The subject invention minimizes this waste of space by utilizing the white space for the generation of a second document, e.g., the unknown useful information. The user will specify an original set of predetermined subjects for which there is a particular interest, and such subjects will be associated with the user as a profile. The subjects generally comprise varying data contents over time, i.e., a varying data stream, having a news-like value to the user. Incidental to the user generating the cover page in the course of a print job, a second document (the first document is the user and job I.D.) is generated for inclusion within the cover page.

It is a particular feature of the invention that the user, i.e., the receiver of the print job, selects the group subjects from which the contents of the second document will be drawn, and that the actual contents are randomly generated from among the specified group of subjects. Such a system provides for a varying pull system for the user in which the user can receive documents that not only vary in content within a certain subject, but also vary by subject as well. As explained in more detail below, this latter novel feature is particularly important in distinguishing the invention from the teachings of the cited Ferrel et al. reference.

The Cited References

The detailed discussions of the references to Cooper and Ferrel which have been made in the record in the detailed prosecution of the subject application and its parent are herein incorporated by reference. In addition, the comments of the Board in its decision of Appeal of the parent of the subject application has also been given a detailed consideration for its assessment of the relevant teachings of the references.

The references either individually, or in combination, fail to suggest a print system wherein the cover page for print job includes a printing of a selected segment of a varying data stream comprising categorizable content from particular user profile group subjects selected by the user so that the user, upon obtaining a print job will receive unknown newsworthy content, constantly varying over time, for the benefit and enjoyment of the user. The content is not related to the corresponding print job.

The Claims Distinguish Over The Teachings of the References

The Examiner will appreciate that claims 1 and 14 have been substantially amended to more specifically define the subject invention and to better distinguish the subject invention over the combined teachings of Cooper and Ferrel et al. In particular, the nature of the varying data stream has been more particularly identified to comprise a categorizable content comprising cartoons, puzzles, stock quotes, weather forecasts, talk schedules, net news articles, and newspaper stories. Such categorizable content is extracted from the varying data stream by identifying the extracted segments as corresponding to preferential areas selected by the user identified in the user profile. The amendment now better distinguishes that the claimed information is different from the data base suggested by Cooper that merely includes a "a list of distribution lists and a list of documents and forms" (Action, page 2) to emphasize the important difference that the varying data stream comprises newsworthy varying content such as can be extracted from the Worldwide Web and that is of newsworthy interest to the user, and not related to the print job content. The citation in Column 8 and 9 of Cooper merely relates to distribution lists information which is directly related to the distribution of the print job itself. On the other hand, the information to be printed in the white space on the cover

page here is now more particularly identified as extracted as segment information from the varying data stream which is unrelated to a content of the print job (claim 1).

CONCLUSION

For the reasons detailed above, it is submitted all claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination and early notice thereof is requested.

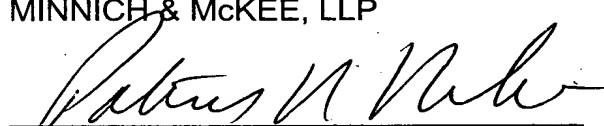
No additional fee is believed to be required for this Amendment A. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Patrick R. Roche, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

February 17, 2005
Date


Patrick R. Roche, Reg. No. 29,580
1100 Superior Avenue, 7th Floor
Cleveland, Ohio 44114-2579
(216) 861-5582